

REMARKS

It is requested that the above amendments be entered for the continuation application filed herewith. The present application is a continuation of U.S. Ser. No. 08/772,293 filed on December 23, 1996, entitled "Inserter Billing System With Electronic Distribution.

Claims 12-36, provided in this amendment, are currently pending in this application. Claims 1-11 are canceled. Claims 12-36 correspond to the claims with the same numbers previously submitted in the parent application.

In the parent application, claims of the same or similar scope were rejected under 35 U.S.C. § 103 based at least in part on U.S. Patent No. 5,802,498 to Comesanas (“Comesanás”). It appears that the Examiner considered Comesanas to be prior art under 35 U.S.C. § 102(e). Comesanas has a § 102(e) priority date of January 11, 1996.

It is respectfully submitted that Comesanas should not be considered prior art under 35 U.S.C. § 102(e) because the applicant invented the subject matter of the present invention prior to January 11, 1996. The applicant's prior invention, and the subsequent continuous activity leading to the filing of the patent application, is documented in the Declaration of Lawrence E. Sklar Under 37 C.F.R. 1.131, filed herewith. This documentation includes Exhibit A, a copy of the original invention disclosure papers created by the inventor, dated June 13, 1995.

Accordingly, the pending claims should not be rejected based on Comesanas. The pending claims are allowable over references in the Information Disclosure Statement filed herewith that may qualify as prior art.

In view of the foregoing, it is respectfully submitted that the claims of this application are in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,



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Version with Markings to Show Changes Made

In the specification:

Title -Please amend the title as follows:

INSERTER BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION

"TOKAY 20" 0000000000